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Paper No. 9
DEB

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re The Mentholatum Company

Serial No. 75/589,320

Richard A. Sharpe of Watts Hoffmann Fisher & Heinke Co. L.P.A.
for The Mentholatum Company.

Andrea P. Hammond, Trademark Examining Attorney, Law Office
115 (Angela Lykos, Acting Managing Attorney).

Before Hanak, Quinn and Bucher, Administrative Trademark
Judges.

Opinion by Bucher, Administrative Trademark Judge:

An application has been filed by The Mentholatum Company
to register the mark STOP IT COLD for "vitamin supplements in
beverage form."¹

The Trademark Examining Attorney has refused registration
under Section 2(d) of the Trademark Act on the ground that
applicant's mark, if applied to applicant's goods, would so
resemble the previously registered mark STOPS PAIN COLD for
"pain relieving gel"² as to be likely to cause confusion, to
cause mistake or to deceive.

¹ Application Serial No. 75/589,320, filed November 16 1998, alleging
a *bona fide* intention to use the mark in commerce.

² Registration No. 2,234,542, issued March 23, 1999.

When the refusal was made final, applicant appealed. Applicant and the Trademark Examining Attorney have filed briefs. An oral hearing was not requested.

We reverse the refusal to register.

Applicant contends that its mark is distinct from the cited mark as to sound, appearance and meaning, resulting in a very different overall commercial impression. With respect to the goods, applicant argues it is most compelling that "[p]ain medication gels and vitamin supplements in beverage form are significantly different goods..." (Applicant's brief, pp. 6-7). Applicant also states that the goods travel in different channels of trade to different classes of purchasers inasmuch as registrant's goods "are only available to health care professionals at this time." (Applicant's brief, p. 9).

The Examining Attorney maintains that the marks are similarly constructed:

...[B]oth marks consist of three word slogans with the same syntax of 'STOP' or 'STOPS' appearing first and COLD appearing last. The examining attorney reiterates that the Applicant merely changes the word 'pain' to 'it,' and deletes the 's' from the word 'stops.' In viewing the mark in its entirety, the phrase 'STOP IT COLD' and 'STOPS PAIN COLD' have a similar connotation, i.e., stopping whatever 'it' is. (Trademark Examining Attorney's brief, unnumbered p. 3).

As to the goods, the Trademark Examining Attorney points out correctly that registrant's identification of goods does

not contain any limitations bearing on channels of trade or classes of purchasers. The application file contains a dozen federal registrations where third parties allegedly adopted and used the same mark "on or in conjunction with vitamin supplements and pain relieving gels/medications/analgesics." (Trademark Examining Attorney's brief, unnumbered p. 6).

Our determination under Section 2(d) is based upon an analysis of all of the facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. See In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

We first turn to consider the goods. It is well settled that the issue of likelihood of confusion between applied-for and registered marks must be determined on the basis of the goods as they are identified in the involved application and cited registration, rather than on what any evidence may show as to the actual nature of the goods, their channels of trade and/or classes of purchasers. Canadian Imperial Bank of Commerce v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987); and In re Elbaum, 211 USPQ 639 (TTAB 1981). The goods need not be identical or even competitive in nature

to support a finding of likelihood of confusion. Instead, it is sufficient that the goods are related in some manner and/or that the circumstances surrounding their marketing are such that they would be likely to be encountered by the same persons under situations that would give rise, because of the marks employed in connection therewith, to the mistaken belief that they originate from or are in some way associated with the same producer or provider. See In re International Telephone & Telegraph Corp., 197 USPQ 910, 911 (TTAB 1978).

On this record, without proof of applicant's allegations about registrant's restrictive channels of trade, we must agree with the Trademark Examining Attorney that these items would appear to travel in the same channels of trade to the same classes of customers.

On the other hand, as argued by applicant in the present case, these respective goods have distinctly different properties. There is certainly no *per se* rule that all items sold in a drug store, for example, are related for purposes of a likelihood of confusion analysis. One item is a topical balm while the other is a beverage to be ingested. The mark in the cited registration is used on one specific item -- pain relieving gels. Applicant intends to use its mark on another rather narrow category of item -- vitamin supplements in beverage form. On this point, we agree with applicant that it

is unlikely they would be sold in the same sections of a retail store.

The Trademark Examining Attorney has submitted for the record a dozen third-party registrations where a single registrant had adopted a single mark and applied it to topical analgesics and to vitamins or dietary supplements. The Trademark Examining Attorney states that these are merely "representative" of the register generally. However, we agree with applicant that this listing is not all that probative inasmuch as many of these marks are indeed house marks (e.g., CVS, Walgreens, Phar-Mor, Stanley, etc.) covering a wide variety of pharmacy and non-pharmacy items.

In sum, we find that while the goods are somewhat related, this factor is largely neutral.

We thus turn to focus our attention on a comparison of applicant's mark STOP IT COLD and registrant's STOPS PAIN COLD mark.

Applicant argues that its mark has a different meaning in light of the fact that its goods are a cold or flu product:

Applicant's mark, STOP IT COLD, is to be used on vitamin supplements in beverage form and sold to cold and flu sufferers. Thus the "COLD" in the mark STOP IT COLD when viewed in connection with its goods cleverly connotes or suggests the common cold and cold-like symptoms. By contrast, STOPS PAIN COLD is used on pain relieving gels. As such, the "COLD" in STOPS PAIN COLD connotes the sensation received

as a result of using the Registrant's pain relieving gels... Registrant's pain relieving gels provide a cold bodily sensation to the user. Hence, the Registrant's use of the word "COLD" is descriptive of the sensation given to the user in the area of the body treated with Registrant's pain relieving gel. (Applicant's brief, p. 4).

Both marks appear to be a play on the term "stopping [something] cold" -- an expression in our vernacular meaning "stopping it abruptly." Yet in context, the term "COLD" in registrant's mark (as applied to a topical analgesic) may well suggest the cool sensation on the skin when the gel is applied. By contrast, in applicant's mark STOP IT COLD, the final two words of this phrase have another double meaning. There is the suggestion that when one fears the on-set of a cold or the flu, one should take this vitamin supplement to end "it" (one's "cold") in an abrupt or unceremonious fashion. Accordingly, we find that when the word "COLD" is applied to the specific goods of applicant and of registrant, these different meanings are the ones most likely to be ascribed to the respective marks.

Regardless of the exact nature of the term "COLD" in the respective marks, the marks also include different terms, namely, "STOP" versus "STOPS" and "PAIN" versus "IT." The Trademark Examining Attorney, having concluded there is a likelihood of confusion, minimizes the differences in the

marks by concluding that applicant has merely changed the word "pain" to "it" and deleted the letter "s" from the word "stops." However, as applicant argues, the singular word "Stop" in STOP IT COLD makes this an imperative statement while the plural "Stops" in STOPS PAIN COLD is a descriptive characterization of what something allegedly does.

Furthermore, as discussed in more detail above, even the words "pain" and "it," as applied to the goods, have quite different meanings. The first (the word "pain") refers to muscle or joint pain, while the second (the word "it") is an allusion to a cold or the flu. In sum, after analyzing applicant's mark and registrant's mark, we find that they are different as to sound, appearance and meaning. As a consequence, we find that the marks in their entireties create very different overall commercial impressions, and that consumers are not likely to be confused if these marks should be applied to these somewhat related but specifically different goods.

Decision: The refusal to register is reversed.